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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,529	02/20/2001	Kazuhiro Kawabata	DAIN:577	5187
25944	7590	07/01/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			BAKER, CHARLOTTE M	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/785,529

Applicant(s)

KAWABATA, KAZUHIRO

Examiner

Charlotte M. Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4,5,12 and 13 is/are allowed.
- 6) ☒ Claim(s) 6-7, 9-11, and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Allowable Subject Matter*

1. Claims 1-2, 4-5, and 12-13 are allowed.

### *Claim Rejections - 35 USC § 102*

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 6-7, 11 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawai et al. (6,891,636).

**Regarding claim 6:** Kawai et al. disclose photographic image reading means for reading a photographic image datum (copying machine 11); advertisement image managing means for storing an advertisement image datum (advertisement image memory 63) and for selecting and extracting an advertisement image datum meeting required conditions (control unit 61 in conjunction with advertisement image memory 63, col. 7, ln. 7-28); fee paying means (Fig. 1, fee charging device 12) for executing a fee paying processing for a specific photographic image datum that is to be output together with the advertisement image datum (col. 4, ln. 40-45); and output means for outputting the specific photographic image datum together with said advertisement image datum (Fig. 3, printer unit 23) after said fee paying processing is executed by said fee paying means (col. 9, ln. 27-30).

**Regarding claim 7:** Kawai et al. satisfy all the elements of claim 6. Kawai et al. further disclose wherein said photographic image reading means and said output means are provided in a store server (col. 8, ln. 23-31), and said advertisement image managing means is provided in an advertisement server which is connected to said store server via a network (col. 8, ln. 32-40).

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**Regarding claim 11:** Kawai et al. satisfy all the elements of claim 6. Kawai et al. further disclose wherein an output matter outputted from said output means (Fig. 3, printer unit 23) is a printed matter on which a photographic image and an advertisement image are laid out in accordance with a predetermined format (col. 7, ln. 46-59 and Fig. 5, S13 and Fig. 6, S29 and Fig. 7, S35 and Fig. 10A, S47 & S49 and Fig. 10C, S52 & S54).

**Regarding claim 14:** The structural elements of apparatus claim 6 perform all of the steps of method claim 14. Thus, claim 14 is rejected for the same reasons discussed in the rejection of claim 6.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. in view of Dutta (6,891,635).

**Regarding claim 9:** Kawai et al. satisfy all the elements of claim 6.

Kawai et al. disclose which is read by said photographic image reading means (copying machine 11); wherein said advertisement image managing means retrieves and extracts an advertisement image datum (advertisement image memory 63).

Kawai et al. fail to specifically address inputting personal information.

Dutta disclose personal data inputting means (client device 110) for classifying personal information on said photographic image datum (col. 3, ln. 6-16 and col. 4, ln. 7-10); to input the

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classified personal information as personal datum (col. 4, ln. 6-16); on the basis of said personal datum, which is inputted by said personal data inputting means (target audience, col. 4, ln. 6-16).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to connect the client device 110 of Dutta to the copying machine 11 of Kawai et al. to facilitate the use of images stored on the client device and available for retrieval on a network. Additionally, based upon the information inputted by the user, a target audience could be determined to offer a selection of advertisements to the user, which may be of interest to them based upon their profession as suggested by Dutta (col. 3, ln. 49-54).

**Regarding claim 10:** Kawai et al. satisfy all the elements of claim 6. Kawai et al. further disclose wherein said photographic image reading means reads a photographic image datum (copying machine 11).

Kawai et al. fail to specifically address a digital camera.

Dutta discloses a client device 110, and connection of a digital camera to a computer is an implicit feature of a computer. Also, the images retrieved from the digital camera could be saved on a storage medium of the client device 110 or network. This is also an implicit feature of a computer. Therefore, Dutta implicitly teaches which has been picked up by a digital camera to be stored in a data storage medium, from said data storage medium.

5. Applicant cannot rely upon the foreign priority papers to overcome the rejections of claims 6-7, 9-11 and 14 because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M. Baker whose telephone number is (571)272-7459. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*KA Williams*  
**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**